

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner rejects claims 1-9 under 35 U.S.C. § 102(b) as being anticipated by JP 2001-256305 to Hommachi (hereinafter “Hommachi”). Additionally, the Examiner rejects claims 10-12 under 35 U.S.C. § 103(a) as being unpatentable over Hommachi.

In response, independent claims 1-3 have been amended to clarify their distinguishing features.

Specifically, independent claims 1 and 2 have been amended to clarify that private information is removed from “the medical information” to be transmitted from the medical treatment/inspection institution to the management institution.

With regard to independent claim 3, the same has been amended to clarify that private information is removed from “the specimen” to be transmitted from the medical treatment/inspection institution to the management institution.

Independent claims 1 and 2 have been further amended to remove the exemplary language recited therein (“such as...”). Such language has been added in new claims 13 and 14. Independent claims 1, 2, 10 and 11 have also been amended to clarify between the medical information that is revised by removing the private information and the medical information that is both revised and changed into a predetermined format.

The amendment to claims 1-3 is fully supported in the original disclosure, such as from page 22, line 19, to page 23, line 3, of the specification. Thus, no new matter has been introduced into the disclosure by way of the present amendment to independent claims 1-3.

Turning now to the prior art, Hommachi discloses a genetic testing data utilization method which comprises a step in which the administering authority inspects individual gene information, a step in which a gene information file recording the gene information and the individual medical record information by associating them without including information which identifies the individual, and a step in which the administering authority submits the gene information and medical record information in this gene information file to a healthcare/medical/food development or production group.

Particularly, in Hommachi, as described in, for example, paragraphs [0016] and [0021] thereof, the administering authority (corresponding to the information management institution in the claimed invention) holds individual information and is able to associate the gene information with individual information.

In contrast, in the claimed invention, as described on page 22, line 19, to page 23, line 3, of the specification, private information (e.g., address, name etc.) is removed at the medical care/test institutions. Therefore, the information management institution does not receive such private information (e.g., address, name). In other words, Hommachi neither discloses nor suggests “transmitting distribution information which has private information removed from medical data to an information management institution” as recited in claims 1 and 2, or “obtaining medical information with regard to the specimen which has private information removed” as recited in claim 3.

The Applicant respectfully submits that the methods of claims 1-3 result in advantages over the prior art, including Hommachi. The advantage of “eliminating the risk of leakage of private information” cannot be realized by the system and methods disclosed in Hommachi.

Furthermore, the Applicant respectfully submits that at least dependent claims 4 to 6 patentably distinguish over Hommachi independently of their base claim for at least the same reasons as set forth above with regard to independent claims 1 to 3.


With regard to the rejection of claims 1-9 under 35 U.S.C. § 102(b), a distribution method of medical information having the features discussed above and as recited in independent claims 1-3, is nowhere disclosed in Hommachi. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”¹ independent claims 1-3 are not anticipated by Hommachi. Accordingly, independent claims 1-3 patentably distinguish over Hommachi and are allowable. Claims 4-9 being dependent upon claims 1-3 are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-9 under 35 U.S.C. § 102(b).

With regard to the rejection of claims 10-12 under 35 U.S.C. § 103(a), since independent claims 1-3 patentably distinguish over the prior art and are allowable, claims 10-12 are at least allowable therewith as depending from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 10-12 under 35 U.S.C. § 103(a).

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Thomas Spinelli
Registration No.: 39,533

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
TS:cm